

REMARKS

This is in full and timely response the non-final Office Action mailed on June 1, 2007.

Claims 24, 29, and 40-59 are currently pending in this application, with claim 24 and 29 being independent.

No new matter has been added.

Reexamination in light of the following remarks is respectfully requested.

Entry of amendment

This amendment *prima facie* places the case in condition for allowance. Alternatively, it places this case in better condition for appeal.

Accordingly, entry of this amendment is respectfully requested.

Prematureness

Applicant, seeking review of the prematureness of the final rejection within the Final Office action, respectfully requests reconsideration of the finality of the Office action for the reasons set forth hereinbelow. See M.P.E.P. §706.07(c).

If the allowance of the claims is not forthcoming at the very least and a new grounds of rejection is made at least against the claims, then a **new non-final Office Action** is respectfully requested at least for the reasons provided hereinbelow.

Final Office Action not necessitated by amendment

Paragraph 6 of the **non-final Office Action** mailed on December 14, 2006 includes a rejection of claims 3-4, 7, 9, 11-16, and 18-19 under 35 U.S.C. §103 as allegedly being unpatentable over International Publication No. WO 02/25842 to Dowling et al. (Dowling).

Within the Amendment in Response to Non-Final Office Action filed on March 2, 2007, claims 3 and 4 have been rewritten **only** to place that claim into independent form. Page 9 of the Amendment includes advisories highlighting that claims 3 and 4 have been rewritten to place those claims into independent form. Thus, claims 3 and 4 found within the Amendment of March 2, 2007 **were present prior to** the mailing on December 14, 2006 of the non-final Office Action.

In response to the Amendment filed on March 2, 2007, pages 2-3 of the **Final Office Action** of June 1, 2007 **admit** that Dowling **does not** expressly disclose a device *wherein the second light source unit has at least two light sources which intermittently emit light beams of the same wavelength, which are independent of each other*, as recited within **claim 3**.

Furthermore, pages 2-3 of the **Final Office Action** of June 1, 2007 **admit** that Dowling **does not** expressly disclose a device *wherein the second light source unit has at least two light sources which intermittently emit light beams of different wavelengths, which are independent of each other*, as recited within **claim 4**.

Nevertheless, paragraphs 3 and 4 of the **Final Office Action** of June 1, 2007 include a **new ground of rejection** of **claims 3 and 4** under 35 U.S.C. §103 as allegedly being unpatentable over Dowling and in view of U.S. Patent No. 6,868,236 to Wiltsey et al. (Wiltsey) and U.S. Patent No. 6,522,437 to Presley et al. (Presley).

Paragraph 13 of the Final Office Action **admits** that the rejections of claims 3 and 4 found within paragraphs 3 and 4 of the Final Office Action are **new grounds of rejection**.

Thus, the new rejection of claims 3 and 4 made within the Final Office Action are new grounds of rejection that are neither necessitated by applicant's amendment of claims 3 and 4 nor based on information submitted in an information disclosure statement.

Accordingly, the finality of the rejection of claims 3-4 made within the Final Office Action is premature at least for this reason.

Petition

A Petition Under 37 C.F.R. §1.181 to Request Withdrawal of the Final Office Action has been previously filed.

Timely consideration of this Petition is respectfully requested.

Rejection under 35 U.S.C. §103

Paragraph 3 of the Office Action includes a rejection of claim 3 under 35 U.S.C. §103 as allegedly being unpatentable over International Publication No. WO 02/25842 to Dowling et al. (Dowling) and in view of U.S. Patent No. 6,868,236 to Wiltsey et al. (Wiltsey) and U.S. Patent No. 6,522,437 to Presley et al. (Presley).

Paragraph 4 of the Office Action includes a rejection of claim 4 under 35 U.S.C. §103 as allegedly being unpatentable over International Publication No. WO 02/25842 to Dowling et al. (Dowling) and in view of U.S. Patent No. 6,868,236 to Wiltsey et al. (Wiltsey).

These rejections are traversed at least for the following reasons.

Claims 3-4 - While not conceding the propriety of these rejections and in order to advance the prosecution of the above-identified application, claims 3-4 have been canceled.

Withdrawal of these rejections and allowance of the claims is respectfully requested.

Paragraph 5 of the Office Action includes a rejection of claims 21, 24-27, 27-32, and 37-38 under 35 U.S.C. §103 as allegedly being unpatentable over Dowling in view of Wiltsey.

This rejection is traversed at least for the following reasons.

Claims 21, 25-27, 27-28, 32, and 37-38 - While not conceding the propriety of these rejections and in order to advance the prosecution of the above-identified application, claims 21, 25-27, 27-28, 32, and 37-38 have been canceled.

Claim 24 - If the allowance of claim 24 is not forthcoming at the very least and a new grounds of rejection made, then a **new non-final Office Action** is respectfully requested for the reasons provided hereinbelow.

Claim 24 has been placed into independent form. Within claim 24, *said information-transmitting unit is mounted on said illumination light source.*

Dowling - The Final Office Action **admits** that Dowling fails to disclose, teach or suggest that the information-transmitting unit is mounted on said illumination light source (Final Office Action at page 4).

Wiltsey - The Final Office Action **admits** that Wiltsey fails to disclose, teach or suggest that the information-transmitting unit is mounted on said illumination light source (Final Office Action at page 4).

Motivation - The Final Office Action on page 4 asserts, without providing any supporting evidence, that:

One can obviously place the information-transmitting unit in any number of suitable locations, including mounting on said illumination light source. At the time the invention was made, it would have been obvious to one of ordinary skill in the art to do so. One of ordinary skill in the art would have been motivated to do this for a compact device.

In response to this assertion, the teachings, suggestions or incentives supporting the obviousness-type rejection must be clear and particular. Broad conclusory statements, standing alone, are not evidence. *In re Dembiczak*, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999).

As a rule, “assertions of technical facts in areas of esoteric technology must always be supported by citation to some reference work recognized as standard in the pertinent art and the appellant given, in the Patent Office, the opportunity to challenge the correctness of the assertion or the notoriety or repute of the cited reference.” (Citations omitted). *In re Pardo and Landau*, 214 USPQ 673, 677 (CCPA 1982). The support must have existed at the time the claimed invention was made. *In re Merck & Co., Inc.*, 231 USPQ 375, 379 (Fed. Cir. 1986).

“Allegations concerning specific ‘knowledge’ of the prior art, which might be peculiar to a particular art should also be supported and the appellant similarly given the opportunity to make a challenge.” (Citations omitted). *In re Pardo and Landau*, 214 USPQ 673, 677 (CCPA 1982).

However, this assertion made within the Office Action of the second light source unit having at least two light sources is merely a *personal conclusion that is unsupported by any objective evidence*.

The Office Action takes Official Notice that one of ordinary skill in the art would have been motivated to do this for a compact device (Final Office Action at page 4).

In response, “it is impermissible, however, simply to engage in a hindsight reconstruction of the claimed invention, using the applicant's structure as a template and selecting elements from references to fill the gaps. The references themselves must provide some teaching whereby the applicant's combination would have been obvious” (citations omitted). *In re Gorman*, 18 USPQ2d 1885, 1888 (Fed. Cir. 1991). See also *In re Dembiczak*, 50 USPQ2d 1614, 1616 (Fed. Cir. 1999) (rejection based upon hindsight is reversed).

- *Applicant hereby requests a reference or an Examiner's affidavit to support this officially noticed position of obviousness or what is well known that one of ordinary skill in the art would have been motivated to do this for a compact device.*

Further, note that if this reference or Examiner's affidavit is not provided, the assertions of what is well known must be withdrawn. See M.P.E.P. §2144.03.

Also, note that the *failure to provide any objective evidence to support the challenged use of Official Notice constitutes clear and reversible error*. *Ex parte Natale*, 11 USPQ2d 1222, 1227-1228 (Bd. Pat. App. & Int. 1989).

In addition, this assertion amounts to nothing more than an “obvious-to-try” situation. Specifically, “an ‘obvious-to-try’ situation exists when a general disclosure may pique the scientist's curiosity, such that further investigation might be done as a result of the disclosure, but the disclosure itself does not contain a sufficient teaching of how to obtain the desired result, or that the claimed result would be obtained if certain directions were pursued.” *In re Eli Lilly & Co.*, 14 USPQ2d 1741, 1743 (Fed. Cir. 1990). Moreover, “an invention is ‘obvious to try’ where the prior art gives either no indication of which parameters are critical or no direction as to which of many possible choices is likely to be successful.” *Merck & Co. Inc. v. Biocraft Laboratories Inc.*, 10 USPQ2d 1843, 1845 (Fed. Cir. 1989).

Here, the cited prior art does not contain a sufficient teaching of how to obtain the desired result, or that the claimed result would be obtained if certain directions were pursued.

“Obvious to try” is not the standard under §103. *In re O'Farrell*, 7 USPQ2d 1673, 1680 (Fed. Cir. 1988).

Claim 29 - If the allowance of claim 29 is not forthcoming at the very least and a new grounds of rejection made, then a **new non-final Office Action** is respectfully requested for the reasons provided hereinbelow.

Claim 29 has been placed into independent form. Within claim 29, said information-transmitting unit includes a recording medium and a reading section,

said reading section being adapted to read information stored in said recording medium,

said recording medium being removable from said information-transmitting unit.

Dowling - The Final Office Action **admits** that Dowling fails to disclose, teach or suggest that the information-transmitting unit includes a recording medium and a reading section, the reading section being adapted to read information stored in the recording medium, the recording medium being removable from the information-transmitting unit (Final Office Action at pages 4-5).

Wiltsey - The Final Office Action **admits** that Wiltsey fails to disclose, teach or suggest that the information-transmitting unit includes a recording medium and a reading section, the reading section being adapted to read information stored in the recording medium, the recording medium being removable from the information-transmitting unit (Final Office Action at pages 4-5).

Motivation - Page 5 of the Final Office Action contends Dowling suggests that memory 150 can be any number of various types of memory.

In response, a true reading of Dowling reveals the following. Dowling at page 39, lines 18-22, provide that:

It will be appreciated that a number of memory devices are known, and may be used in a lighting subsystem 132 according to the principles of the invention. For

example, the memory 150 may be a flash memory, read-only memory, or some other non-volatile memory, or the memory may be a random access memory, dynamic random access memory, or some other volatile memory.

However, conspicuously absent from the listing at page 39, lines 18-22, of Dowling is the presence of the recording medium being *removable* from the information-transmitting unit.

Yet, the Final Office Action on page 5 asserts, without providing any supporting evidence, that:

Notice that Any suitable removable memory would be another obvious type of memory for Dowling, e.g., a floppy disk. One of ordinary skill in the art would have been motivated to do this since removable memory is easy to replace, reprogram, and transport.

In response to this assertion, the teachings, suggestions or incentives supporting the obviousness-type rejection must be clear and particular. Broad conclusory statements, standing alone, are not evidence. *In re Dembiczak*, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999).

As a rule, “assertions of technical facts in areas of esoteric technology must always be supported by citation to some reference work recognized as standard in the pertinent art and the appellant given, in the Patent Office, the opportunity to challenge the correctness of the assertion or the notoriety or reputation of the cited reference.” (Citations omitted). *In re Pardo and Landau*, 214 USPQ 673, 677 (CCPA 1982). The support must have existed at the time the claimed invention was made. *In re Merck & Co., Inc.*, 231 USPQ 375, 379 (Fed. Cir. 1986).

“Allegations concerning specific ‘knowledge’ of the prior art, which might be peculiar to a particular art should also be supported and the appellant similarly given the opportunity to make a challenge.” (Citations omitted). *In re Pardo and Landau*, 214 USPQ 673, 677 (CCPA 1982).

However, this assertion made within the Office Action of the second light source unit having at least two light sources is merely *a personal conclusion that is unsupported by any objective evidence*.

The Office Action takes Official Notice that one of ordinary skill in the art would have been motivated to do this for a compact device (Final Office Action at page 4).

In response, “it is impermissible, however, simply to engage in a hindsight reconstruction of the claimed invention, using the applicant's structure as a template and selecting elements from references to fill the gaps. The references themselves must provide some teaching whereby the applicant's combination would have been obvious” (citations omitted). *In re Gorman*, 18 USPQ2d 1885, 1888 (Fed. Cir. 1991). See also *In re Dembiczak*, 50 USPQ2d 1614, 1616 (Fed. Cir. 1999) (rejection based upon hindsight is reversed).

- *Applicant hereby requests a reference or an Examiner's affidavit to support this officially noticed position of obviousness or what is well known that one of ordinary skill in the art would have been motivated to do this since removable memory is easy to replace, reprogram, and transport.*

Further, note that if this reference or Examiner's affidavit is not provided, the assertions of what is well known **must** be withdrawn. See M.P.E.P. §2144.03.

Also, note that the *failure to provide any objective evidence to support the challenged use of Official Notice constitutes clear and reversible error*. *Ex parte Natale*, 11 USPQ2d 1222, 1227-1228 (Bd. Pat. App. & Int. 1989).

In addition, this assertion amounts to nothing more than an “obvious-to-try” situation. Specifically, “an ‘obvious-to-try’ situation exists when a general disclosure may pique the scientist's curiosity, such that further investigation might be done as a result of the disclosure, but the disclosure itself does not contain a sufficient teaching of how to obtain the desired result, or that the claimed result would be obtained if certain directions were pursued.” *In re Eli Lilly & Co.*, 14

USPQ2d 1741, 1743 (Fed. Cir. 1990). Moreover, “an invention is ‘obvious to try’ where the prior art gives either no indication of which parameters are critical or no direction as to which of many possible choices is likely to be successful.” *Merck & Co. Inc. v. Biocraft Laboratories Inc.*, 10 USPQ2d 1843, 1845 (Fed. Cir. 1989).

Here, the cited prior art does not contain a sufficient teaching of how to obtain the desired result, or that the claimed result would be obtained if certain directions were pursued. “Obvious to try” is not the standard under §103. *In re O’Farrell*, 7 USPQ2d 1673, 1680 (Fed. Cir. 1988).

Withdrawal of this rejection and allowance of the claims is respectfully requested.

Paragraph 6 of the Office Action includes a rejection of claims 22-23 under 35 U.S.C. §103 as allegedly being unpatentable over Dowling in view of Wiltsey and further in view of U.S. Patent No. 5,218,466 to Brooks.

Paragraph 7 of the Office Action includes a rejection of claim 26 under 35 U.S.C. §103 as allegedly being unpatentable over Dowling and in view of Wiltsey and Presley.

Paragraph 8 of the Office Action includes a rejection of claim 33 under 35 U.S.C. §103 as allegedly being unpatentable over Dowling and in view of Wiltsey and in further view of Ramaswami et al., *Optical Networks: A Practical Perspective*, 2nd Ed., pp. 165-176 (Ramaswami).

Paragraph 9 of the Office Action includes a rejection of claim 34 under 35 U.S.C. §103 as allegedly being unpatentable over Dowling and in view of Wiltsey and in further view of Ramaswami.

Paragraph 10 of the Office Action includes a rejection of claim 35 under 35 U.S.C. §103 as allegedly being unpatentable over Dowling and in view of Wiltsey and in further view of Service, Hot New Beam May Zap Bandwidth Bottleneck (Service).

Paragraph 11 of the Office Action includes a rejection of claim 36 under 35 U.S.C. §103 as allegedly being unpatentable over Dowling and in view of Wiltsey and in further view of Service and Ramaswami.

Paragraph 12 of the Office Action includes a rejection of claim 39 under 35 U.S.C. §103 as allegedly being unpatentable over Dowling in view of Wiltsey and further in view of U.S. Patent No. 6,198,230 to Leeb et al. (Leeb).

These rejections are traversed at least for the following reasons.

Claims 22-23, 26, 33-36, 39 - While not conceding the propriety of these rejections and in order to advance the prosecution of the above-identified application, claims 22-23, 26, 33-36, 39 have been canceled.

Withdrawal of these rejections is respectfully requested.

Newly added claims

Newly added claims 40-59 are dependent upon claim 24. Thus, newly added claims 40-59 are allowable at least for the reasons provided hereinabove with respect to claim 24. Newly added claims 40-59 are also allowable at least for the features that they recite.

Allowance of the claims is respectfully requested.

Conclusion

For the foregoing reasons, all the claims now pending in the present application are allowable, and the present application is in condition for allowance. Accordingly, favorable reexamination and reconsideration of the application in light of the remarks is courteously solicited.

Extensions of time

Please treat any concurrent or future reply, requiring a petition for an extension of time under 37 C.F.R. §1.136, as incorporating a petition for extension of time for the appropriate length of time.

Fees

If any fee is required or any overpayment made, the Commissioner is hereby authorized to charge the fee or credit the overpayment to Deposit Account # 18-0013.

If the Examiner has any comments or suggestions that could place this application in even better form, the Examiner is requested to telephone Brian K. Dutton, Reg. No. 47,255, at 202-955-8753.

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Respectfully submitted,

By 

Ronald P. Kananen

Registration No.: 24,104

RADER, FISHMAN & GRAUER PLLC

Correspondence Customer Number: 23353

Attorney for Applicant